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|------------------------------------|---|----------------------|
| In re Application of | : | |
| SANTAMARIA | : | |
| Application No.: 10/537,989 | : | DECISION ON PETITION |
| PCT No.: PCT/EP2003/013951 | : | |
| Int. Filing Date: 09 December 2003 | : | UNDER |
| Priority Date: 09 December 2002 | : | |
| Attorney Docket No.: 613-97 | : | 37 CFR 1.497(d) |
| For: ANHYDROUS CRYSTALLINE FORM | : | |
| OF VALACYCLOVIR HYDROCHLORIDE | : | |

This decision is in response to applicant's "REQUEST TO CORRECT INVENTORSHIP UNDER 37 CFR § 1.48(a)" filed in the United States Patent and Trademark Office (USPTO) on 14 December 2005, which has properly been treated as a petition under 37 CFR 1.497(d).

BACKGROUND

On 09 December 2003, applicants filed international application PCT/EP2003/013951, which designated the United States and claimed a priority date of 09 December 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 24 June 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 09 June 2005.

On 09 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage.

On 07 March 2005, applicants filed the instant "REQUEST TO CORRECT INVENTORSHIP UNDER 37 CFR § 1.48(a)", which has properly been treated as a petition under 37 CFR 1.497(d). The petition was accompanied by, *inter alia*, a declaration of Antoni Santamaria, a declaration of Pau Cid, and a declaration of inventors identifying Pau Cid as the sole inventor and signed by him.

On 17 July 2006, the United States Designated/Elected Office mailed a NOTICE OF ACCEPTANCE OF APPLICATION (Form PCT/DO/EO/903) according the application a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of 14 December 2005.

DISCUSSION

The NOTICE OF ACCEPTANCE OF APPLICATION mailed 17 July 2006 was mailed in error (i.e., before a decision on applicant's petition under 37 CFR 1.497(d) had been rendered) and is hereby VACATED.

37 CFR 1.497(d), provides:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92^{bis} subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in Sec. 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Applicants have satisfied items (1) and (2).

Item (3) has not been satisfied. No mention is made in the petition regarding whether an assignment has been executed. If an assignment has been executed, the written consent of the assignee is required. See MPEP § 324 for a proper showing under 37 CFR 3.73(b).

As to item (4), a new declaration is not required by 37 CFR 1.497(f) in the instant situation.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED** without prejudice for the reasons set forth above.

The NOTICE OF ACCEPTANCE OF APPLICATION mailed 17 July 2006 is **VACATED** for the reasons set forth above.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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